

Response to Official Action
Application No. 09/625,792
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Amendments to the Drawings:

No amendments are made to the Drawings herein.

REMARKS

By the foregoing Amendment, Claims 1, 15, 17, 18 and 20 are amended and Claims 14 and 19 are cancelled. Entry of the Amendment, and favorable consideration thereof is earnestly requested.

Claims 18 and 19 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Claim 18 has been amended in such a manner that Applicant respectfully submits that Claim 18 is now clearly supported by the specification as originally filed (see page 14, last paragraph and Figures 2 and 3). Claim 19 has been cancelled.

All pending claims stand rejected under 35 U.S.C. §103(a) as being unpatentable primarily over Mizuno et al. (U.S. Patent No. 4,274,423) in view of Corl et al. (U.S. Patent No. 5,715,827) and Hoek et al. (U.S. Patent No. 6,312,380). Applicant respectfully asks the Examiner to reconsider these rejections in view of the above Amendments and the below Remarks.

Claims 1, 17 and 20, all independent Claims, have been amended essentially to incorporate the limitations of previously pending Claim 14, and now require, among other limitations, that the wireless readable data carrier comprises a transponder and an antenna for receiving and sending electromagnetic interrogation and answering signals. Applicant respectfully submits that none of the cited prior art, either when taken individually or when combined, disclose, teach or suggest these highlighted elements in any way.

Mizuno et al. and Corl et al. disclose pressure sensor arrangements for use with catheters or guide wires which may be introduced, for example, into a patient's arteries or veins in order to measure the pressure therein. Although

Mizuno et al. and Corl et al. disclose the use of transponders, the transponders used therein are pressure transponders for sensing the pressure within the patient's arteries or veins. There is absolutely no disclosure, teaching or suggestion of a transponder and an antenna for receiving and sending electromagnetic interrogation and answering signals as is required by all pending claims, as amended.

Hoek et al. discloses a system for the wireless measurement of physiological variables, which includes a resonance sensor disposed on a guide wire or the like, which is inserted into a patient's body. The resonance sensor may be responsive to various types energy (such as electromagnetic energy, ultrasonic energy, etc.). A transducer, such as an electromagnetic transducer, an ultrasonic transducer, or the like, is positioned outside of, and possibly in contact with, the patient's body, and energy is introduced into the patient's body. The sensor element receives the incident waves of energy and enters into a resonating state, the characteristics of the resonance corresponding to the variable or variables to be measured. The transducer receives the scattered wave and transmits a resultant signal to an electronic drive and detection unit for signal analysis.

Thus, while Hoek et al. discloses a transducer, there is absolutely no disclosure, teaching or suggestion that the transducer is, could, or should be disposed within a recess in a medical instrument. Rather, Hoek et al. discloses that it is the resonance sensor that may be disposed on or in a medical instrument (e.g., a guide wire).

In view of the above, Applicant respectfully submits that no combination of cited references would arrive at or render obvious the present invention, as claimed. It is well settled that the mere fact that references can be combined or

modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination or modification. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). It is also well settled that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

In the present case, Applicant respectfully submits that there is absolutely no motivation or suggestion in the prior art to arrive at a medical instrument having a wireless readable data carrier, which comprises a transponder and an antenna for receiving and sending electromagnetic interrogation and answering signals, embedded in a recess formed in an outer surface thereof, as is required by all claims, as amended. Moreover, Applicant respectfully submits that if the pressure transponder of Mizuno et al., the primary cited reference, were replaced with the claimed transponder and antenna for receiving and sending electromagnetic interrogation and answering signals, Mizuno et al. would no longer perform its intended function of measuring pressure within arteries or veins.


Furthermore, it should be noted that if the references were combined as suggested by the Examiner, the hypothetical device resulting from the combination would be a pressure sensing catheter for measuring the pressure within a patient's arteries or veins (as taught by Mizuno et al.) employing a resonance sensor adapted to measure pressure and being responsive to energy produced by a transducer positioned outside the patient's body (as taught by Hoek et al.), with the catheter having a recess configured according to Mizuno et al. and Corl et al. The resulting combination would not include a transponder and an antenna for receiving and sending electromagnetic interrogation and answering signals,

embedded in a recess formed in an outer surface of a medical instrument, as is required by all claims, as amended.

In view of the fact that Claim 1 is now in condition for allowance, Applicant respectfully submits that withdrawn Claims 7, 10 and 15, which depend from Claim 1, should be entitled to consideration and are also in condition for allowance.

For the foregoing reasons, Applicant respectfully submits that all pending claims, namely Claims 1, 4, 5, 7-13, 15, 17, 18, 20 and 21, are patentable over the references of record, and earnestly solicits allowance of the same.

Respectfully submitted,



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